AF/3617

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/775,425
Filing Date	February 1, 2001
First Named Inventor	Lee A. Chase
Group Art Unit	3617
Examiner Name	Russell D. Stormer
Total Number of Pages in This Submission	
Attorney Docket Number	LII153B US

ENCLOSURES *(check all that apply)*

- [ ] Fee Transmittal Form
  - [ ] Fee Attached
- [x] Amendment / Reply
  - [x] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
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Remarks: **Postcard.**

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Remy J. VanOphem
Signature	
Date	February 5, 2003

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: February 5, 2003

Typed or printed name	Remy J. VanOphem		
Signature		Date	February 5, 2003

#17
3/5/03

EXPEDITED PROCEDURE
AMENDMENT AFTER FINAL
GROUP ART UNIT NO. 3679

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

NOTED 3/6/03

Serial No.	09/775,425	Examiner:	R. Stormer
Inventor:	Chase et al.	Group Art Unit:	3617
Filing Date:	February 1, 2001		
Title:	Vehicle Wheel and Overlay Assembly		

* * * * * * * * * * *

REPLY TO OFFICE ACTION UNDER 37 CFR §1.116

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

To highlight the distinction of the above referenced invention over the prior art as interpreted by the Examiner in the Office Action of November 5, 2002, Paper No. 16, no amendments were made to the claims or specification and the undersigned offers the following remarks.

Applicants wish to express their appreciation to the Examiner for the indication in item 1, page 2 of the Final Office Action that all objections regarding the term "net" have been overcome.

The undersigned attorney further wishes to express his appreciation to the

Examiner for the interview granted on January 28, 2003. Specifically, the purpose of the interview was to request clarification with respect to paragraphs 2 and 14 of the last Office Action as well as prior Office Actions concerning the same subject matter as stated in paragraph 2 of the Office Action of November 5, 2002. Mainly, this concerns the fact that the undersigned had carefully reviewed the statements made by the Examiner and was totally confused as to their meaning as so stated in the responses filed requesting clarification of the same. Since this was a continuing problem, as evidenced by three separate Office Actions, the undersigned scheduled an interview with the Examiner to obtain clarification with respect to the rejections and the allegations of record by the Examiner especially those in paragraph 2 of the latest Office Action, dated November 5, 2002. Upon a thorough review and discussion with the Examiner of the prosecution history since April 9, 2001, the Examiner stated that there was a typographical error in the specific rejection of paragraph 1 of the Office Action mailed May 10, 2002. The Examiner identified a typographical error, which clarified the rejection. Accordingly, the Examiner retracted the statements of paragraph 2 of the November 5, 2002 Action as such statements were predicated on a typographical error in the Office Action and therefore should not prejudice the inventor or the owner of record of the current application.

During the interview, the Examiner expressed uneasiness about certain comments deemed to be derogatory to the prior art of record found on page 16 of Applicants' response filed August 9, 2002. Such statements support a legal argument concerning the disclosure of the prior art references and are not intended to be derogatory

with respect to the validity of the prior art since a patent is issued with the presumption of validity. The undersigned merely points out that the disclosure of the prior art does not support the claim of the present invention and accordingly, cannot anticipate the claims of the invention under the 102 statute nor obviate the claims of invention under a 103 rejection.

In items 3 and 4 on page 2 of the Final Office Action, the Examiner rejected Claims 1, 10 and 11 under 35 U.S.C. §102(b) as being anticipated by Todd, U.S. Patent 5,143,426. The undersigned attorney respectfully traverses the Examiner's rejection of independent Claim 1 and dependent Claims 10 and 11 in view of the following argument.

In items 3 and 5 of the Final Office Action, the Examiner rejected Claims 1, 4, 5, 8, 10 and 11 under 35 U.S.C. §102(e) as being anticipated by Eikhoff, U.S. Patent 5,829,843. The undersigned attorney respectfully traverses the Examiner's rejection of independent Claims 1 and dependent Claims 4-5, 8 and 10-11 in view of the following argument.

In items 3 and 6 of the Final Office Action, the Examiner rejected Claims 1, 10 and 11 under 35 U.S.C. §102(b) as being anticipated by Buerger, U.S. Patent 5,031,965. Again, the undersigned attorney also respectfully traverses the Examiner's rejection of independent Claim 1 and dependent Claims 10-11 in view of the following argument.

In items 3 and 7 of the Final Office Action, the Examiner rejected **for the**

first time Claims 1, 4, 5, 10, 11, 15, 18, 19, 20, 24 and 25 under 35 U.S.C. §102(b) as being anticipated by Beam, U.S. Patent 5,368,370. The undersigned attorney respectfully traverses the Examiner's rejection of independent Claims 1 and 15 and dependent Claims 4-5, 10-11, 18-20 and 24-25 in view of the following argument.

In items 3 and 8 of the Final Office Action, the Examiner rejected **for the first time** Claims 1, 4, 5, 6, 11, 15, 18, 19, 20 and 25 under 35 U.S.C. §102(b) as being anticipated by Maloney et al., U.S. Patent 5,435,631. The undersigned attorney respectfully traverses the Examiner's rejection of independent Claims 1 and 15 and dependent Claims 4-6, 11, 18-20 and 25 in view of the following argument.

In items 3 and 9 of the Final Office Action, the Examiner rejected **for the first time** Claims 1, 4, 6, 8, 11, 13, 14, 15, 18, 20, 22, 25, 27 and 28 under 35 U.S.C. §102(b) as being anticipated by Chase et al., U.S. Patent 5,564,791. The undersigned attorney respectfully traverses the Examiner's rejection of independent Claims 1 and 15 and dependent Claims 4, 6, 8, 11, 13-14, 18, 20, 22, 25, 27 and 28 in view of the following argument.

In items 3 and 10 of the Final Office Action, the Examiner rejected **for the first time** Claims 1, 2, 3, 9, 11, 15, 16, 17, 23 and 25 under 35 U.S.C. §102(b) as being anticipated by Murray et al., U.S. Patent 5,842,750. The undersigned attorney respectfully traverses the Examiner's rejection of independent Claims 1 and 15 and dependent Claims 2-3, 9, 11, 16-17, 23 and 25 in view of the following argument.

The test for determining if a reference anticipates a claim, for purposes of

a rejection under 35 U.S.C. §102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals of the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. §102, the Court stated:

> "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Applicants' amended independent Claim 1 requires:
"A wheel and overlay assembly, comprising:

a wheel having an outboard surface thereon, said wheel further having a disk portion and a rim portion circumscribing said disk portion, said rim portion having a rim flange circumscribing said rim portion, said rim flange terminating in a flange lip defining a radially outermost edge thereon; and

an overlay having an outboard surface thereon, said overlay being attached to said outboard surface of said wheel, said overlay further having a web portion, and a peripheral flange circumscribing said web portion and terminating in a peripheral lip, **said peripheral lip having a radially outermost edge aligned within a predetermined margin of said radially outermost edge of said flange lip of said wheel such that said peripheral lip of said overlay cannot extend radially beyond said outermost edge of said flange lip of said wheel regardless of tolerance variations of said overlay and said wheel**;

whereby said overlay gives a visible impression that said outboard surface of said overlay is actually said outboard surface of said wheel and not a separately attached component of said wheel and overlay assembly."

Applicants' independent Claim 15 requires:
"A wheel and overlay assembly, comprising:

a wheel having an outboard surface thereon, said wheel further having a disk portion and a rim portion circumscribing said disk portion, said rim portion having a rim flange circumscribing said rim portion, said rim flange terminating in a flange lip defining a radially outermost edge thereon, said radially outermost edge defining an outer diameter, said flange lip having an outboard surface portion; and

an overlay having an outboard surface thereon, said overlay being attached to said outboard surface of said wheel, said overlay further having a web portion and a peripheral flange circumscribing said web portion and terminating in a peripheral lip, said peripheral lip having an inboard surface portion located net against said outboard surface portion of said flange lip, said peripheral lip having a radially outermost edge defining a diameter, **said diameter of said overlay being within a predetermined margin less than said outer diameter of said wheel such that said peripheral lip of said overlay cannot extend radially beyond said outermost edge of said flange lip of said wheel regardless of tolerance variations of said overlay and said wheel**;

whereby said overlay gives a visible impression that said outboard surface of said overlay is actually said outboard surface of said wheel and not a separately attached component of said wheel and overlay assembly."

Todd, Eikhoff, Buerger, Beam, Maloney et al., Chase et al. and Murray et al. fail to disclose an overlay element with a "peripheral lip having a radially outermost edge aligned within a predetermined margin of said radially outermost edge of said flange lip of said wheel such that said peripheral lip of said overlay **cannot extend radially beyond said outermost edge of said flange lip** of said wheel regardless of tolerance variations of said overlay and said wheel" as required in Applicants' independent Claims

1 and 15.

None of the Examiner's cited references, including Todd, Eikhoff, Buerger, Beam, Maloney et al., Chase et al. and Murray et al., disclose a peripheral lip of a wheel cover having a radially outermost edge aligned within a predetermined margin of the radially outermost edge of a wheel, and in fact none even discuss such a predetermined margin. Furthermore, none of the cited references include any disclosure pertaining to an arrangement of elements adapted to ensure that the peripheral lip of the overlay **cannot extend** radially beyond the outermost edge of a wheel regardless of tolerance variations. It is clear to any person skilled in the art that any disclosure or drawing illustrations wherein a nominal wheel cover is shown to extend to the edge of the wheel inherently gives rise to some wheel covers that, due to tolerance variations, are oversized and extend beyond the edge of the wheel. Accordingly, any drawing illustrations or statements in the specification that discloses a wheel cover designed to radially extend to the edge of the wheel and does not set forth specific disclosure regarding a structure or arrangement adapted to account for tolerance variations and to ensure that the wheel cover **cannot extend** radially beyond the wheel does not anticipate Applicants' Claims 1 and 15.

The previously cited *Lindemann* reference provides that "Anticipation requires... disclosure of each and every element of the claimed invention, arranged as in the claim." None of the references relied on by the Examiner disclose an overlay element arranged as in Applicants' Claims 1 and 15 that specifically describes alignment of the

overlay within a predetermined margin of the wheel to insure the overlay **cannot extend** beyond the edge of the wheel regardless of tolerance variations.

In response to the Examiner's contention in item 14, page 7 of the Final Office Action providing that the diameters of the overlays disclosed by Todd, Eikhoff and Buerger are substantially the same, but not greater than the diameters of the rim flanges, it is respectfully suggested that the disclosure referred to lacks enablement with regard to the overlay not extending radially beyond the diameter of the rim flange and therefore does not anticipate Applicants' invention. Disclosure of a wheel cover designed to extend to the radial edge of the rim implicitly allows for the wheel cover to extend radially beyond the rim due to tolerance variations as is well known to a person skilled in the art. Therefore, any disclosure of a wheel cover extending radially to the edge of the rim, and that does not specifically disclose allowances for tolerance variations to ensure that the cover cannot extend beyond the edge of the rim, cannot enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In other words, one skilled in the art that makes and/or uses a wheel assembly based on disclosure providing a wheel cover designed to extend to the radial edge of the rim will produce wheel covers that, due to tolerance variations, extend beyond the edge of the rim and therefore because of the lack of specific disclosure to ensure that the cover cannot extend beyond the wheel diameter does not anticipate Applicants' invention.

In item 14, page 7 of the Final Office Action, the Examiner's Response to Arguments section provides:

> "Applicants argue that the Todd, Eikhoff, and Buerger patents do not recognize the problems associated with a wheel cover which extends beyond the radially outermost edge of the rim. This cannot be true because all of the references show the outermost lips of the covers or overlays as extending up to but not beyond the outermost edge of the wheel rim."

The undersigned acknowledges that the drawing figures illustrate that the edge of the covers appear to extend up to the edge of the wheel. However, this is insufficient to aid the person skilled in the art to understand that the claims as pending require that under no circumstance may the cover extend radially beyond the edge of the wheel. The reference lacks disclosure as to the structural limitations required and it is not inherent to a person skilled in the art from an inspection of the drawings of these various prior art references that the peripheral lip of the overlay has "... a radially outermost edge aligned within a predetermined margin of said radially outermost edge of said flange lip of said wheel such that said peripheral lip of said overlay cannot extend radially beyond said outermost edge of said flange lip of said wheel..." as specifically recited in both independent claims 1 and 5.

In item 14, page 8 of the Final Office Action, the Examiner's Response to Arguments section further provides:

> "Since each of the patents teaches that the cover or overlay extends up to but not beyond the outermost edge of the wheel rim flange, there is no reason to speculate that the covers or overlays can extend beyond the rim flanges, regardless of tolerance variations of the overlay or the wheel rim."

> "The arguments on page 10 suggesting that disclosures of the patents used in the rejection somehow "implicitly allow for the wheel cover to extend beyond the outermost edge of the wheel due to tolerance variations" is not understood..."

In view of Applicants' failure to make this point explicitly clear in the prior response, it will be reiterated hereinafter and then explained in greater detail. As previously stated in Applicants' Amendment filed August 2, 2002, the Todd reference discloses at column 3, lines 35-36 "...the peripheral edge 34 of the fascia 26 extends to the edge of the wheel." A person skilled in the art will know that this limited disclosure implicitly allows for the wheel cover to extend beyond the outermost edge of the wheel due to tolerance variations, and therefore is clearly distinguishable from Applicants' disclosure providing an overlay element having a diameter within a predetermined margin less than the diameter of the wheel to ensure the overlay **cannot extend radially beyond the edge of the wheel,** regardless of tolerance variations. Unless all tolerance variations are taken into account such that the wheel cover at the maximum material or tolerance condition extends no further than the edge of the wheel, a certain percentage of wheel covers manufactured according to a design wherein the cover extends to the edge of the wheel will inherently extend beyond the edge of the wheel.

In item 14, page 9 of the Final Office Action, the Examiner's Response to Arguments section further provides:

> "More than an "incidental suggestion," Todd clearly teaches that the lip or edge 34 of the facial extends to the

> edge of the wheel as stated in lines 35 and 36 of column 3. The drawings clearly show the outer edge of the rim to be covered by the outer periphery of the overlay and further show that the overlay does not extend beyond the rim flange."

In the response filed August 2, 2002, Applicants' address the Examiner's contention in the Office Action dated May 5, 2002 that the summation of the teachings of the patent to Todd as an incidental suggestion is offensive to the patent system, and that Todd is not silent on the positioning of the overlay on the wheel as the drawings clearly show the overlay extending to the edge of the rim, it is respectfully suggested that the Examiner has misinterpreted the controlling authority in *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45 (1923); *Gray Telephone Pay Station Co. v. Baird Mfg. Co.*, 174 F. 417 (7th Cir. 1909); *A.R. Mosler & Co. v. Lurie*, 209 F. 364 (2nd Cir. 1913); and *United States Metallic Packing Co. v. Hewitt Co.*, 236 F. 739 (7th Cir. 1916). Applicants' representative did not suggest that the disclosure in Todd is incidental because it is not clearly shown, rather it was indicated that the disclosure is incidental because Todd does not provide any explanation as to the significance of the relationship between the outermost radial edge of the overlay and the outermost radial edge of the wheel rim. Having previously clarified this point in the Amendment filed August 2, 2002, it is difficult to properly respond to the Examiner's subsequent response to arguments cited immediately above which provides in part "More than an "incidental suggestion," Todd clearly teaches... The drawings clearly show". In light of Applicants' clarification regarding the term "incidental", and the distinction between that which is

clearly shown and that which lacks explanation as to the significance of a relationship, it is difficult to understand why the Examiner replies by alleging that Todd provides more than an "incidental suggestion" because of the clarity of the teaching and drawings.

Todd is completely silent regarding advantages and/or disadvantages of the aforementioned relationship, and does not make clear that the relationship is essential to the invention. As Todd does not recognize any of the advantages and/or disadvantages attributable to the relationship between the outer radial edge of the overlay and the outer radial edge of the wheel rim, any results there from are unintended and unappreciated, and do not constitute anticipation. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, supra. Additionally, Todd's arrangement of the outer radial edge of the overlay relative to the outer radial edge of the wheel rim is incidentally shown, is not essential to the invention, and therefore does not constitute anticipation. *Gray Telephone Pay Station Co. v. Baird Mfg. Co.*, supra; *Mosler & Co. v. Lurie*, supra; and *United States Metallic Packing Co. v. Hewitt Co.*, supra. This matter was discussed with the Examiner during the interview because the Examiner interpreted the statement regarding Todd as questioning the validity of the issued Patent. This interpretation is groundless since as the Examiner states, patents are presumed valid upon issue. Applicants are merely stating that Todd's incidental disclosure in column 3, lines 35 and 36 is clearly insufficient for the purpose of enabling the limitation " ...said peripheral lip having a radially outermost edge aligned within a predetermined margin of said radially outermost edge of said flange lip of said wheel such that said peripheral lip of said overlay cannot extend radially

beyond said outermost edge of said flange lip of said wheel regardless of tolerance variations of said overlay and said wheel...".

Beam, Maloney et al., Chase et al. and Murray et al. fail to disclose an overlay element wherein the "diameter of said overlay being within a predetermined margin less than said outer diameter of said wheel such that said peripheral lip of said overlay cannot extend radially beyond said outermost edge of said flange lip of said wheel regardless of tolerance variations of said overlay and said wheel" as required in Applicants' independent Claim 15. More precisely, none of the cited references disclose an overlay element arranged within a predetermined margin less than the outer diameter of the wheel. Furthermore, none of the cited references include any disclosure pertaining to such a predetermined margin arranged to ensure that the peripheral lip of the overlay cannot extend radially beyond the outermost edge of a wheel.

Therefore, in applying the test for anticipation as set forth in *Lindemann*, neither Todd, Eikhoff nor Buerger anticipate either independent Claim 1 or 15. Accordingly, withdrawal of the rejection of independent Claims 1 and 15, as well as dependent Claims 4, 6, 8, 10-11, 15, 18-19, and 22-25 which are but delineations of the invention set forth in the independent claims from which they depend, under 35 U.S.C. §102 is respectfully requested.

In items 11 and 12 on page 6 of the Final Office Action, the Examiner rejected Claims 2, 3, 8 and 9 under 35 U.S.C. §103(a) as being obvious over the teachings of Todd. Additionally, in items 11 and 13 on page 6 of the Final Office Action, the

Examiner rejected Claims 2, 3, 6, 8 and 9 under 35 U.S.C. §103(a) as being obvious over the teachings of Eikhoff. Applicants' attorney respectfully traverses each of the 35 U.S.C. §103 rejections for the reason that Applicants' invention is not an obvious improvement over the prior art.

With respect to the rejections under 35 U.S.C. §103, it is noted in MPEP Section 706 that the standard of patentability to be followed in the examination of a patent application is that which was enunciated by the Supreme Court in *Graham v. John Deere*, 148 USPQ 459 (1966), where the Court stated:

> "Under Section 103, the scope and the content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved."

Accordingly, to establish a prima facie case of obviousness, the Patent Office must: (1) set forth the differences in the claim over the applied references; (2) set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and (3) explain why the proposed modifications would be obvious. To satisfy step (3) above, the Patent Office must identify where the prior art provides a motivating suggestion, inference or implication to make the modifications proposed in step (2) above. *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992). Prior to discussing the unobviousness of the present invention over the prior art, the teachings of the prior art references and the differences, novelty, and unobviousness of the present invention over the prior art references will be set forth. From the following prior art

teachings, it is clear that there are no suggestions, inferences, or implications whatsoever to obviate Applicants' invention.

Todd, U.S. Patent 5,143,426, is directed to the problem of reduction of vehicle weight by the use of a process of attachment of a plastic overlay coating to a polystyrene base that has been molded to the desired configuration of the component.

To overcome this problem Todd teaches an "in situ" molding process to make a wheel and overlay assembly having a polystyrene base that is molded into the general configuration of the wheel against the metal rim. Applied to the molded base by a low pressure injection molding process is a thermoplastic fascia that is allowed to flow around the base to form a mechanical lock, eliminating the need for adhesives. To secure the fascia to the underlying polystyrene base or wheel in the case of the vehicle wheel, the thermoplastic material flows around the edges of the vent openings engaging the underlying wheel rim to secure the overlay to the rim. The thermoplastic fascia 26 is molded over the foam core 24 such that a mechanical lock is formed, thereby eliminating the need for adhesives.

The fascia 26 and base 24 are molded such that openings 28 corresponding to the vent openings 20 of the rim 12 and bores 30 corresponding to the bolt holes 16 are formed to provide the required access. The mechanical lock of the fascia 26 around the base 24 and to the rim 12 is formed through the vent openings 20 by molding the thermoplastic around the edges of the openings 20. A flanged lip 32 is formed to secure the fascia 26 to the steel wheel. For added securement, the lip 32 may also be formed

around the boltholes 16. As a result of this mechanical attachment, no adhesive is required. In a preferred embodiment, the peripheral edge 34 of the fascia 26 extends to the edge of the wheel. This same securement principal can be used in other components which have spaced openings such as dashboards or instrument panels. In components which do not include openings, the fascia material may be extended completely around the base material 24 to completely enclose the material.

Beyond this incidental suggestion, Todd is absolutely silent with respect to the relationship of the overlay coating with respect to the axial or radial edge of the wheel. When viewed in terms of the general teachings of the several embodiments of Todd, Todd is completely contrary to the structure of the Applicants' preferred embodiment and the features associated therewith because Todd teaches as well as suggests that "the fascia material may be extended completely around the base material 24 to completely enclose the material." Column 3, lines 39-41.

Clearly, the incidental reference with respect to the preferred embodiment of Figures 1 and 2 fails to recognize the problem Applicants have recognized with respect to the relationship between the peripheral outermost edge of the overlay with respect to the outer edge of the wheel. Accordingly, the structural elements taught by Todd to the preferred embodiment of Figures 1 and 2 where the fascia appears to extend to the axial edge of the wheel but beyond the radial edge of the wheel cannot possibly apply to the alternate embodiment of Figures 4a and 4b where the radial edge of the fascia appears to be in line with the radial edge of the wheel as the part is illustrated in the mold. In fact,

they appear to be completely contrary to the disclosure of Figures 1 and 2 since none of the advantageous features recited by Todd with respect to his preferred embodiment relate in anyway whatsoever to the incidental disclosure of the alternate embodiment of Figures 4a and 4b.

Eikhoff, U.S. Patent 5,829,423, is directed to the problems associated with prior art wheel cover retention systems using an expanding adhesive material where the adhesive material is insufficient to retain the wheel cover on the wheel.

To solve this problem, Eikhoff teaches a wheel cover retention system wherein the outboard tire bead seat retaining flange of the associated wheel includes a unique machined lock construction for securing a wheel to the cover. The outboard tire bead set retaining flange includes an outer surface having a circumferential radially inwardly facing groove portion therein. The wheel cover includes an outer annular lip, that includes a locking shoulder 64 to extend into the locking catch 62 of the locking arrangement 60. An extended flange portion 54 extends over the top of the rim flange to encase the rim flange and lies within a rim relief area 66 along the tire side of the rim flange.

Applicants' invention is directed to the lack of a cost effective method of achieving an individual aesthetic appearance of a cladded vehicle wheel without wrapping the edge of the cladding or cover around the flange lip of the rim flange of the wheel.

To overcome the problems associated with prior art wheel and cover

assemblies, Applicants teach a device wherein the overlay is brought radially outward to ensure the entire outboard face of the wheel is covered, including the flange lip of the rim flange without the costly technique of wrapping the overlay around the flange lip of the rim flange at an economical cost without jeopardizing the structural integrity of the wheel assembly.

The overlay as taught by Applicants' invention is permanently secured to a wheel such that under max/min tolerance conditions the overlay is brought radially outward to cover the entire outboard face of the wheel, including the flange lip of the rim flange of the wheel, without extending radially beyond the outer diameter of the wheel. The present invention includes a wheel having an outboard surface defined by a disk, and a rim circumscribed about the disk. The rim's radial outer periphery (or the disk's outer periphery in the case of a full face wheel) is defined by a rim flange having a flange lip at the axially outermost edge. The overlay has an outboard surface with a web portion, and an integral peripheral flange or rim flange portion circumscribed about the web portion. Further, the peripheral flange or rim flange portion of the overlay also terminates in a flange lip as the radially outermost edge. The peripheral flange portion of the overlay has an inboard surface that is near to the axially outermost edge or flange lip of the rim flange of the wheel, while the radially outermost edge or flange lip of the peripheral flange portion of the overlay is circumferentially aligned within a predetermined tolerance variation of the radially outer periphery of the rim flange of the wheel, such that the peripheral flange portion of the overlay covers the flange lip of the rim flange of the

wheel without wrapping over the edge of the wheel or going beyond the peripheral outermost edge of the wheel. This relationship gives a visible impression to the observer of the vehicle or wheel alone that the entire outboard surface of the overlay is actually the entire outboard surface of the wheel. This impression is accomplished without wrapping the overlay's peripheral flange portion around the flange lip of the rim flange, as with some previous prior art. This technique also results in giving an impression to the observer that the wheel is larger than what it should be due to the added thickness of the metal wrapped around the rim flange.

The differences between Applicants' invention and the prior art references cited by the Examiner are quite clear. In the Eikhoff reference, the teachings of the preferred embodiment are completely contrary to the Applicants' teachings of not permitting the overlay to wrap around the flange lip of the rim flange.

Moreover, Todd's disclosure is unclear as to the relationship of the fascia overlap condition with the underlying wheel's structural features. Frankly, there is no disclosure whatsoever in the Todd publication when considering how the adhesive interrelates with the overlay and wheel surface or how the structure of the outer edge of the overlay relates to the edge of the wheel. Also, since Todd teaches that the curled boundary of the fascia 32 helps to secure the overlay to the wheel at the windows and bolt holes it completely fails to suggest, other than an incidental comment, how the outer edges of the overlay and wheel cooperate to provide the impression that the overlay is the wheel. Further, Todd clearly teaches that no adhesive is needed.

Thus, Todd's incidental suggestion that the peripheral edge 34 of the fascia extends to the edge of the wheel is insufficient enablement to form the basis of a rejection against Applicants' claims which, according to the requirements of 35 U.S.C. §112, define clear structural differences of an overlay having a claimed relationship at its outer boundaries with the wheel's outer edge and wherein the overlay is adhesively directly attached to the outer surface of the wheel.

The Examiner alleges that the tolerances and margins between the lip of the overlay and the flange lip taught by Applicants are obvious design expedients that combine with either Todd or Eikhoff to obviate Applicants' structural claimed relationship. It is, however, respectfully suggested that one skilled in the art would have no basis for combining the teachings of Todd or Eikhoff in the manner suggested by the Examiner since neither of these references recognizes the problems solved by Applicants' invention. Specifically, neither Todd nor Eikhoff recognize the problems associated with a wheel assembly having a wheel cover radially extending beyond the edge of the rim. As neither reference even recognized such problems, there can be no motivation or suggestion to include a predetermined margin as a solution thereto. Absent recognition of the problem faced by Applicants, the prior art cannot possibly suggest, singularly or in combination, a solution as novel as Applicants' invention. Furthermore, as none of the Examiner's references recognize the problems associated with a wheel cover radially extending beyond the rim, the Patent Office cannot possibly identify where the prior art provides a motivating suggestion, as required in element 3 of the In re Jones analysis

cited hereinabove, to make the modifications suggested by the Examiner.

Assuming arguendo that Todd and Eikhoff teach a wheel cover extending to the radial edge of the rim as suggested by the Examiner, such disclosure still fails to obviate Applicants' invention. A person skilled in the prior art will recognize that disclosure teaching a wheel cover designed to extend to the radial edge of the rim implicitly allows for the wheel cover to extend radially beyond the rim due to tolerance variations (i.e. when there is a maximum material condition for the cover and a minimum material condition for the rim). Therefore, any reference teaching a wheel cover extending radially to or beyond the edge of the rim, and that does not make allowances for variation to specifically insure that the cover **cannot extend** beyond the edge of the rim, is contrary to Applicants' teachings for the reasons set forth in the specification. Thus, it is only through Applicants' teachings and disclosure that one of ordinary skill in the art would appreciate the need for such claimed structural arrangement between the associated edges of the overlay and wheel to provide unique aesthetic configurations to a vehicle wheel. In view of this, a person of ordinary skill in the art would not seek to use the teachings of the references cited by the Examiner to produce the result that Applicants' invention as claimed teaches.

Even if, as the Examiner suggests, the teachings of Todd or Eikhoff singularly or in combination were used in an attempt to obviate Applicants' invention, it is clear from these teachings that the suggested combination could not result in Applicants' invention and would in fact require extensive additional disclosure as well as

structure in an attempt to acquire similar results. Specifically, neither reference teaches or suggests alignment of a wheel cover relative to a rim so that the cover **cannot extend** beyond the rim of the wheel. Additionally, neither reference teaches structure including a wheel cover having a diameter substantially equal to but not greater than the outer diameter of the wheel, such that manufacturing and assembly variation can never result in a wheel cover assembly in which the cover extends radially beyond the rim.

The undersigned attorney respectfully submits that independent Claims 1 and 15 are clearly allowable over the disclosure and any teachings of Todd and Eikhoff taken by themselves or in combination. Further, under principles of claim dependency, Todd and Eikhoff do not anticipate Applicants' dependent Claims 2-3, 6, 8-10, 13, 16-17, 20, 22-23 and 27 either. Accordingly, Applicants' invention is an unobvious improvement over the prior art and not an obvious modification of any of the references cited by the Examiner. Reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. §103(a) are, therefore, respectfully requested.

The Examiner's Response to Arguments in item 10 on page 5 of the Office Action has been fully considered, and Applicants' attorney respectfully disagrees based on the arguments and controlling authority cited on page 22, line 14 through page 24, line 7 of the amendment filed October 19, 2001 and incorporated by reference herein, as well as the following remarks.

In response to the Examiner's contention that the diameters of the overlays disclosed by Todd, Eikhoff and Buerger are substantially the same, but not greater than

the diameters of the rim flanges, it is respectfully suggested that the disclosure referred to is not enabling and therefore does not anticipate Applicants' invention, Seymour v. Osborne, 78 U.S. 516 (1870), and University of California v. Eli Lilly and Co., 39 USPQ2d 1225, 1242 (S.D. Ind. 1995), aff'd., 43 USPQ2d 1398 (Fed. Cir. 1997). Disclosure of a wheel cover designed to extend to the radial edge of the rim to a person skilled in the art implicitly allows for the wheel cover to extend radially beyond the rim due to tolerance variations. Therefore, any reference teaching a wheel cover extending radially to or beyond the edge of the rim, and that does not make allowances for tolerance variations to specifically insure that the cover **cannot extend** beyond the edge of the rim, cannot enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention as set forth in the claims. In other words, one skilled in the art that makes and/or uses a wheel assembly based on disclosure providing a wheel cover designed to extend to the radial edge of the rim will produce wheel covers that, due to tolerance variations, extend beyond the edge of the rim and therefore do not anticipate Applicants' invention.

In response to the Examiner's contention that the summation of the teachings of the patent to Todd as an incidental suggestion is offensive to the patent system, and that Todd is not silent on the positioning of the overlay on the wheel as the drawings clearly show the overlay extending to the edge of the rim, it is respectfully suggested that the Examiner has misinterpreted the controlling authority in Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45 (1923); Gray Telephone Pay Station

Co. v. Baird Mfg. Co., 174 F. 417 (7th Cir. 1909); A.R. Mosler & Co. v. Lurie, 209 F. 364 (2nd Cir. 1913); and United States Metallic Packing Co. v. Hewitt Co., 236 F. 739 (7th Cir. 1916). Applicants' representative did not suggest that the disclosure in Todd is incidental because it is not clearly shown, rather it was indicated that the disclosure is incidental because Todd does not provide any explanation as to the significance of the relationship between the outer radial edge of the overlay and the outer radial edge of the rim. In fact, Todd is completely silent regarding advantages and/or disadvantages of the aforementioned relationship, and does not make clear that the relationship is essential to the invention. As Todd does not recognize any of the advantages and/or disadvantages attributable to the relationship between the outer radial edge of the overlay and the outer radial edge of the rim, any results therefrom are unintended and unappreciated, and do not constitute anticipation. Eibel Process Co. v. Minnesota & Ontario Paper Co., supra. Additionally, Todd's arrangement of the outer radial edge of the overlay relative to the outer radial edge of the rim is incidentally shown, is not essential to the invention, and therefore does not constitute anticipation. Gray Telephone Pay Station Co. v. Baird Mfg. Co., supra; Mosler & Co. v. Lurie, supra; and United States Metallic Packing Co. v. Hewitt Co., supra.

In item 14, page 9 of the Final Office Action, the Examiner's Response to Arguments section further provides:

> "Further, it is suggested that Applicant becomes familiar with 37 C.F.R. 1.3. In the future, papers submitted by the instant Applicant which contain offensive comments

> will be forwarded to the Office of the Director with the request that they be returned to the Applicant."

It is suggested that the entire record be submitted to the Office of the Director as any violation of the decorum and courtesy requirements of 37 C.F.R. §1.3 are solely attributable to the language in the Office Action that was identified by the Examiner as containing a typographical error. The above citation is yet another example of the Examiner's offensive and inflammatory language set forth in paragraph 14 which the Examiner graciously withdrew as a result of the interview.

In view of the finality of the Office Action, every attempt has been made to place the claims in condition for allowance and it is respectfully asserted that there are no further issues, formal or substantive, that remain for prosecution. Formal allowance of the application is, therefore, respectfully solicited. In the event the Examiner is not persuaded of the patentability of the claims as amended herein, he is respectfully requested to enter the amendment for purposes of appeal.

The Commissioner is hereby authorized to charge any deficiency in fee associated with this amendment to the undersigned's Deposit Account No. 22-0212. If the Examiner has any questions with respect to any matter now of record, Applicants' attorney may be reached at (248) 362-1210.

Respectfully submitted,

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Certificate under 37 CFR §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on February 5, 2003.

Date: February 5, 2003

Remy J. VanOphem, Reg. No. 27053